

REMARKS

Claims 2, 3, 5-7, 11, 12, 17 and 19 stand rejected under 35 USC 112, second paragraph as being indefinite. Applicant has amended the claims to address the issues identified by the Examiner. Applicant respectfully submits that these rejections are now moot.

Claims 1, 4-7 and 10-11 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,257,212 to Kasket (hereinafter “Kasket”). Applicant respectfully disagrees with the Examiner’s analysis. A rejection based on anticipation “requires that all of the elements and limitations of the claim [be] found within a single prior art reference.” *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q. 1001, 1010 (Fed. Cir. 1986)(citing *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 138, 231 U.S.P.Q. 644, 646 (Fed. Cir. 1986)). “If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground [for rejection] is not a §102 anticipation.” *Id.* Kasket does not show all the elements of claim 1. The language of claim 1 recites “**a body portion comprising overlying layers of porous material that are joined to form at least one compartment, said at least one compartment carrying** infusion beverage product in addition to **a weight that causes said body portion to sink in water.**” Such a “porous” body portion is not found in the Kasket reference.

More particularly, the package of Kasket includes a stick 10 with a plastic pouch 7 that surrounds the stick 10. A metal weight 13 is integrally attached to the bottom of the stick 10 or the plastic pouch 7. A porous bag 6 (referred to as an "envelope") is attached to the plastic pouch 7. This configuration does not provide a weight carried by a "porous" compartment as recited in claim 1, which is easy to use and inexpensive to implement. Instead, the beverage package of Kasket employs a metal weight 13 that is integrally attached to the bottom of the stick 10 or to a "non-porous/impervious" plastic pouch 7, which is cumbersome and expensive to implement because the weighted member is far bigger than the porous bag to which it is attached. Thus, Kasket fails to teach or suggest important limitations of the claim. For these reasons, Applicant respectfully submits that claim 1 is clearly not anticipated by Kasket.

The dependent claims 3-19 are patentable over the cited prior art for those reasons advanced above with respect to Kasket and for reciting additional features that are neither taught or suggested by the cited prior art.

For example, claim 8 recites that the weight comprises "a dissolvable agent." Claim 9 recites that "said dissolvable agent comprises a sweetener." Nowhere does the cited prior art teach or suggest these features. The Examiner rejects claims 8 and 9 under 35 USC 103(a) as being obvious over Kasket. The Examiner's analysis of claims 8 and 9 is flawed as it relies on prohibited hindsight to form the previously unobvious invention. See, *In re Piasecki*, 745 F. 2d 1468, 223 U.S.P.Q. 785, 789 (Fed. Cir. 1984); *Novo Industri A/S v Travenol Laboratories, Inc.*, supra at 417 (7th Cir. 1982); *Hughes Aircraft*

Co. v. United States, *supra* at 804 (Ct. Claims 1982); *In re Rinehart*, 531 F. 2d 1048, 189 U.S.P.Q. 143, 148-149 (C.C.P.A. 1976). Moreover, as the court in *Hughes Aircraft Co. v. United States*, 215 U.S.P.Q. 787, 804 (Ct. Claims, 1982) noted: "In any consideration of obviousness, it is always necessary to be vigilant against the possibility of hindsight creeping into the analysis. One way that the courts have guarded against hindsight is by insisting that the reason for making the suggested changes be apparent, at the time the invention was made, to a person of ordinary skill in the art". More particularly, in order to establish a *prima facie* case of obviousness under 35 U.S.C. 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify the prior art reference or to combine reference teachings to arrive at the claimed invention. *Ex parte Clapp*, 227 U.S.P.Q. 972 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art **and not from the Applicant's disclosure**. *Uniroyal, Inc. v. Ridkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Nowhere has the Examiner provided any teaching, suggestion or inference in the prior art as a whole (or from the knowledge generally available to one of ordinary skill in the art) for modifying Kasket to show the weight as a dissolvable agent/sweetener. Instead, the Examiner relies on hindsight reasoning provided by the Applicant's disclosure. For these reasons, the Examiner has failed to establish a *prima facie* case of obviousness for claims 8 and 9.

In another example, claim 16 requires "a bottom wall that extends between the two body portions **(that extend from a hinged interface)**, said bottom wall and two

body portions defining a space for solution to flow through during steeping, and wherein said bottom wall has a compartment for carrying said weight.” Nowhere does the cited prior art teach or suggest these features. The Examiner rejects claim 16 under 35 USC 103(a) as being obvious over Kasket in view of U.S. Patent No. 3,542,561 to Rambold. The Examiner’s analysis of claim 16 is flawed as it relies on prohibited hindsight to form the previously unobvious invention. More particularly, the Examiner’s analysis fails to provide any teaching, suggestion or inference in the prior art as a whole (or from the knowledge generally available to one of ordinary skill in the art) for modifying Kasket and Rambold to show the weight carried with a “bottom wall compartment” as required by claim 16. Instead, the Examiner relies on hindsight reasoning provided by the Applicant’s disclosure. For these reasons, the Examiner has failed to establish a prima facie case of obviousness for claim 16.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jay P. Sbrollini". The signature is fluid and cursive, with a long horizontal stroke at the end.

Jay P. Sbrollini
Reg. No. 36,266
Attorney for Applicant(s)

GORDON & JACOBSON, P.C.
60 Long Ridge Road
Suite 407
Stamford, CT 06902
Ph:(203) 323-1800

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